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In the Supreme Court of the United States

OCTOBER TERM, 1940.

SCHRIBER-SCHROTH COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.
No. 9.

ABERDEEN MOTOR SUPPLY COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.
No. 10.

F. E. ROWE SALES COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.
No. 11.

AFFIDAVIT OF THOMAS E. ROBERTSON
and
SUPPLEMENT TO THE RESPONDENTS' BRIEF ON THE MOTION TO REMAND.

ARTHUR C. DENISON,
F. O. RICHEY,
WM. C. MCCOY,
MILTON TIBBETTS,
Counsel and Solicitors for Respondents.

THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO

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AFFIDAVIT OF THOMAS E. ROBERTSON.

DISTRICT OF COLUMBIA, SS.

THOMAS E. ROBERTSON, being duly sworn, deposes and says:

I am of mature age, and for twelve years, from April 1921 to June 1933, was Commissioner of Patents in active supervision of the United States Patent Office. While the application of Jardine, Serial No. 364,997, filed March 11, 1920, and resulting in issuance of patent No. 1,763,523, granted on June 10, 1930, involved in the above entitled causes, was originally filed before I was Commissioner, all

the proceedings relating to the interferences involving said Jardine application took place during my tenure of office. Owing to the fact that I was practicing before the Patent Office for thirty years before my appointment as Commissioner and because it was necessary for me to make rules and regulations governing all proceedings in the Patent Office during the twelve years of my Commissionership, in accordance with R. S. 483, I was familiar with the rules and regulations regarding the declarations of interferences.

It was the uniform practice in the Patent Office in interference cases that a claim in interference must be given the broadest construction its language would bear, this rule being made mandatory by decisions of the Court of Appeals for the District of Columbia, which then had jurisdiction of appeals from the Patent Office. In fact, under the mandatory control of the Court of Appeals any claim which was made the basis of an interference in which a plurality of applications was involved must necessarily be construed broadly enough to read upon each and all of those applications.

In Interference No. 49,578 there were involved five applications, namely, the aforesaid Jardine application, and applications of the parties Day, Spillman, Hartog and Long. In that particular interference the count, Claim 18 (19E), necessarily had to be construed by the Examiner broadly enough to read on each of those five applications in order to permit him to declare the interference. In fact, in interference proceedings, if at any time a different or limited construction is placed upon the issue of an interference such as to make it unreadable on any one of the applications involved, that very fact would necessitate the dissolution of the interference. The construction originally given to this claim in the Patent Office was never changed during the interference proceedings. As this claim was construed in the Patent Office only the elements directly stated were considered and no other elements were read into it.

I have examined the drawings of the Long and Spillman applications which were involved with Jardine in In-

terference No. 49,578. I have read the opinion of this Court in the above entitled causes, handed down on December 4, 1940, and have noted the construction given by this Court to Claim 18 (19E) which was the claim involved in that interference. If the claim had been construed in the Patent Office to include the expressions "retraction of the skirt from the bosses" and "balanced flexibility" it would have made necessary a dissolution of the interference for the reason that such expressions were not readable upon the structures of Long and Spillman.

Claim 18 (19E) was broad enough to read on all five applications involved in the interference. In contrast therewith Claim 8 of the Jardine patent is so narrow that it does not read on the Long and Spillman applications. The Patent Office did not allow any claims to Jardine which were broader than the said interference claim but did allow Claims 1, 8 and 15 of the Jardine patent which were narrower than the interference claim.

(Sgd.) THOMAS E. ROBERTSON.

Subscribed and sworn to before me this 11th day of January, 1941.

(Sgd.) MARY C. BEVANS,
Notary Public.

Affidavit of Service.

DISTRICT OF COLUMBIA, SS.

I, B. D. Watts, being duly sworn, depose and say that on January 11, 1941, I served a copy of the foregoing affidavit on counsel for petitioner by mailing such copy by first class mail, postage prepaid, and addressed to counsel for petitioner.

(Sgd.) B. D. WATTS.

Subscribed and sworn to before me this 11th day of January, 1941.

(Sgd.) MARY C. BEVANS,
Notary Public.

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SUPPLEMENTAL BRIEF ON THE MOTION TO REMAND.

A patent is a contract. There are two parties to the contract, i.e., the inventor, represented by his solicitor, and the public, represented by the Commissioner of Patents. The patent is a final memorial of the intention of the parties, just as is any other contract. We furnished an affidavit of the solicitor for Jardine in connection with our former brief and have submitted since an affidavit of Mr. Thomas E. Robertson who was Commissioner of Patents at the time the counts of the interferences, including 18 (19E)

were made, prosecuted and cancelled from the Jardine application. This affidavit is printed *supra*. Mr. Robertson's statement completes the evidence on the subject of the scope given these counts and particularly this count 18 (19E) when it was made in, prosecuted in and cancelled from the Jardine application. The evidence furnished by the two parties to the contract is the same. Mr. Robertson's affidavit establishes conclusively the following propositions:

(a) Claim 18 (19E) (like the other amended and cancelled claims) was never given the narrow construction that this Court gave it but, on the contrary, was given a broad construction and a construction which was broader than the allowed claims, and consequently Jardine did not abandon what this Court thought he had abandoned, on the basis of which thought its opinion in this case was predicated.

(b) That because of the disclosure in the applications of Long and Spillman, the cancelled and amended claim 18 (19E) could not have been given the construction which this Court gave it and that, therefore, the Patent Office did not allow broad claims after rejecting narrow ones, as this Court said (p. 8 of its opinion) but, on the contrary, that the Patent Office allowed narrower claims after the cancellation of the broad claims and, therefore, that this Court is mistaken in saying and holding as follows:

> "it does not appear why the Patent Office allowed the broad claims after rejecting the narrower ones." (p. 8 of this Court's opinion.)

This evidence of the two parties to the proceedings is directly affirmed by the action of the other four parties to the interference, since had the cancelled and amended claims been given the interpretation which this Court gave them and under which they would not have read upon either the Long or the Spillman disclosures, there would have been a Motion to Dissolve the interference by Long, by Spillman, by Hartog, or by Day on that ground. We will show, if given the chance, that though Long and

Hartog each made motions to dissolve, none were made on the grounds here involved. It results that the views of this Court upon which its opinion and holding are predicated are, therefore, contrary to the records, to the views of the Commissioner of Patents and Jardine's solicitor (the two parties to the contract) and to the other four parties to the interference.

The holding is also contrary to the views of the petitioners (defendants) who pleaded in the answers in these causes that the allowed claims were more limited and restricted than the cancelled claims. Thus we find in Section 33 of the Answers (R. p. 23) the following:

> "Further answering, defendant avers that during the prosecution of each of the applications of each of the patents in suit, the claims thereof were limited and restricted in the light of the prior art cited by the Examiner and on account of rejections by the Examiner;"

This latter proposition also confirms the statements in our brief on this motion that the issue upon which the Court decided this case was not pleaded. Section 33, from which we have quoted, not only shows that it was not pleaded, *but that the contrary was pleaded,* i.e., *the pleading made the issue and the only issue on this question, the proposition that the allowed claims were narrower and more restricted than the cancelled claims.* This Court's holding is just the reverse.

Manifestly, under the circumstances, the parties and the Court below are entitled to a consideration of this issue upon the evidence which bears upon it in order that the rights of the parties may be ascertained and sustained and justice done.

ARTHUR C. DENISON,
F. O. RICHEY,
WM. C. MCCOY,
MILTON TIBBETTS,
Counsel and Solicitors for Respondents.